

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Jerding, *et al.*

Confirmation No.: 1598

Group Art Unit: 2623

Serial No.: 09/590,904

Examiner: Shang, Annan Q.

Filed: June 9, 2000

Docket No. A-6585 (191930-1180)

For: **PROGRAM INFORMATION SEARCHING SYSTEM FOR INTERACTIVE PROGRAM GUIDE**

APPEAL BRIEF UNDER 37 C.F.R. §41.37

Mail Stop Appeal Brief - Patents
Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Appeal Brief under 37 C.F.R. § 41.37 is submitted in support of the Notice of Appeal filed on January 23, 2008, responding to the final Office Action mailed September 13, 2007, rejecting claims 2, 3, 5-30, 32-37, and 39-64 in the present application and making the rejection Final, and to the Advisory Action mailed January 4, 2008, which maintained the rejection. In addition, a Pre-Appeal Brief Request for Review and accompanying remarks in support thereof were filed January 23, 2008, and the Panel Decision dated June 17, 2008 indicated that there remains at least one issue for appeal. Further, Appellants filed evidence under 37 CFR §41.37 on July 15, 2008, the evidence which is included in Section IX of the present appeal brief.

I. REAL PARTY IN INTEREST

The real party in interest of the instant application is Scientific-Atlanta, Inc., having its principal place of business at 5030 Sugarloaf Parkway, Lawrenceville, GA 30044. Scientific-Atlanta, Inc., the assignee of record, is wholly owned by Cisco Systems, Inc.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF THE CLAIMS

Claims 2, 3, 5-30, 32-37, and 39-64 are indicated in the Final Office Action as standing rejected. Claims 1, 4, 31, 38 were cancelled during prosecution of the present case. Further, Appellants cancelled claims 55-58 in the November 14, 2007 response after final. The Advisory Action maintained the Final rejection, but neglected to indicate whether the claims cancelled in the November 14 response were entered. Accordingly, Appellants believe the cancellations to be proper and should have been entered absent what appears to be an administrative error. However, if the claim cancellations were denied entry, Appellants believe such denial to be improper, and present claims 2, 3, 5-30, 32-37, 39-54, and 59-64 as the subject of the present appeal.

IV. STATUS OF AMENDMENTS

As explained above, amendments have been made or requested since the mailing of the Final Office Action. In particular, claims 55-58 were cancelled in the response after final, but the status of those claim amendments were not indicated in the Advisory Action or in the Panel Decision. As the claim cancellations were proper, Appellants will treat those claims as

cancelled and address the rejections to claims 2, 3, 5-30, 32-37, 39-54, and 59-64 as the proper subject of the present appeal. All amendments submitted prior to the Final Office action have been entered. A copy of the current claims subject to this appeal is included in Section VIII of the present appeal brief.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Embodiments of the claimed subject matter are illustrated in FIGs. 1-10 and are discussed in the specification at least at pages 1-12.

Embodiments of the claimed subject matter, such as those defined by claim 63, define a programmable television services client device for enabling a user to search for television program information (see e.g., Figure 2, reference numeral 16, and page 4, lines 18-22 and page 6, line 17 – page 7, line 18), said client device comprising: memory (see e.g., Figure 2, reference numeral 30, and page 5, lines 3-21) comprising: program information corresponding to a plurality of television programs (see e.g., Figure 2, reference numeral 40, and page 6, lines 17-36); an initial interactive program guide (IPG) arrangement (see e.g., Figure 4, reference numeral 70, and page 9, line 11 – page 10, line 16); and a user interface (UI) module (see e.g., Figure 2, reference numeral 39, and page 6, lines 17-36); and a processor (see e.g., Figure 2, reference numeral 24, and page 5, lines 3 – 21) configured with the UI module to associate the program information with the initial IPG arrangement (see e.g., page 6, line 17 – page 7, line 13), the processor further configured with the UI module to: present the initial IPG arrangement on a display device (see e.g., Figure 2, reference numeral 21, and page 7, lines 3-13; page 9, line 11 – page 10, line 16), the initial IPG arrangement including a channel area (see e.g., Figure 4, reference numeral 78, and page 9, line 35 – page 10, line 1), a first program display area (see e.g., Figure 4, reference numeral 76, and page 9, lines 11-28) adjacent the channel

area, and a browse-by icon (see e.g., Figure 4, symbol or icon labeled "A", and page 10, lines 1-16); receive a first user input corresponding to selection of the browse-by icon (see page 10, lines 17-36); present a first IPG arrangement on the display device responsive to the first user input (see e.g., Figure 6, reference numeral 90, and page 11, lines 1-14), the first IPG arrangement comprising a browse-by area (see e.g., Figure 6, reference numeral 91, and page 11, lines 1-14) that displaces the channel area, the browse-by area having a search option (see e.g., Figure 6, reference numeral 92, and page 11, lines 9-14); receive a second user input corresponding to selection of the search option (see e.g., page 11, lines 9-14); present a second IPG arrangement on the display device responsive to the second user input (see e.g., Figure 7, reference numeral 100, and page 11, lines 9 – 28), the second IPG arrangement comprising a user input field (see e.g., Figure 7, reference numeral 101, and page 11, lines 15-28) that displaces the browse-by area; receive a third user input corresponding to a search term, the third user input entered through the user input field (see e.g., Figure 8, reference numeral 111, and page 11, line 29 – page 12, line 2); search the program information based on the search term (see e.g., page 11, line 29 – page 12, line 2); and present a third IPG arrangement on the display device responsive to the search (see e.g., Figure 9, reference numeral 120, and page 12, lines 4-15), the third IPG arrangement comprising a second program display area that displaces the user input field, the second program display area comprising a search result (see e.g., Figure 9, reference numeral 121, and page 12, lines 3-15) comprising the program information for a portion of the plurality of television programs where the search term is in a respective television program title (see e.g., Figure 9, such as the listing of "world" in the program titles).

Embodiments of the claimed subject matter, such as those defined by claim 8, further define the programmable television services client device of claim 63, wherein the program

information comprises a television program title for each of the plurality of television programs (see, e.g., Figure 4, such as program title, "Saving Private Ryan," and page 9, lines 11-28).

Embodiments of the claimed subject matter, such as those defined by claim 9, further define the programmable television services client device of claim 8, wherein the search is limited to television programs corresponding to a time period selected through user input from a list of two or more time periods (e.g., see page 12, lines 3-15).

Embodiments of the claimed subject matter, such as those defined by claim 10, further define the programmable television services client device of claim 9, wherein a default time period selection consists of the current day and the following day (see e.g., page 10, lines 17 – 36).

Embodiments of the claimed subject matter, such as those defined by claim 11, further define the programmable television services client device of claim 9, wherein a default time period selection is the current day (see e.g., page 10, lines 17-36).

Embodiments of the claimed subject matter, such as those defined by claim 12, further define the programmable television services client device of claim 9, wherein the time period is specified through user input (see e.g., page 10, lines 17-36).

Embodiments of the claimed subject matter, such as those defined by claim 13, further define the programmable television services client device of claim 9, wherein the portion of the plurality of television programs resulting from the search are scheduled during at least a part of said time period (see e.g., page 10, lines 17-36).

Embodiments of the claimed subject matter, such as those defined by claim 14, further define the programmable television services client device of claim 13, wherein the search result includes a television program title and a television program starting time (see e.g., page 12, lines 3-15).

Embodiments of the claimed subject matter, such as those defined by claim 64, define a method for implementing a programmable television services client device (see e.g., Figure 2, reference numeral 16, and page 4, lines 18-22 and page 6, line 17 – page 7, line 18) to enable a user to search for television program information, said method for implementing a programmable television services client device comprising the steps of: presenting an initial IPG arrangement on a display device (see e.g., Figure 2, reference numeral 21, and page 7, lines 3-13; page 9, line 11 – page 10, line 16), the initial IPG arrangement including a channel area (see e.g., Figure 4, reference numeral 78, and page 9, line 35 – page 10, line 1), a first program display area (see e.g., Figure 4, reference numeral 76, and page 9, lines 11-28) adjacent the channel area, and a browse-by icon (see e.g., Figure 4, symbol or icon labeled “A”, and page 10, lines 1-16); receiving a first user input corresponding to selection of the browse-by icon (see page 10, lines 17-36); presenting a first IPG arrangement on the display device responsive to the first user input (see e.g., Figure 6, reference numeral 90, and page 11, lines 1-14), the first IPG arrangement comprising a browse-by area (see e.g., Figure 6, reference numeral 91, and page 11, lines 1-14) that displaces the channel area, the browse-by area having a search option (see e.g., Figure 6, reference numeral 92, and page 11, lines 9-14); receiving a second user input corresponding to selection of the search option (see e.g., page 11, lines 9-14); presenting a second IPG arrangement on the display device responsive to the second user input (see e.g., Figure 7, reference numeral 100, and page 11, lines 9 – 28), the second IPG arrangement comprising a user input field (see e.g., Figure 7, reference numeral 101, and page 11, lines 15-28) that displaces the browse-by area; receiving a third user input corresponding to a search term, the third user input entered through the user input field (see e.g., Figure 8, reference numeral 111, and page 11, line 29 – page 12, line 2); searching the program information based on the search term; and presenting a third IPG arrangement on the display device responsive to

the search, the third IPG arrangement comprising a second program display area that displaces the user input field, the second program display area comprising a search result (see e.g., Figure 9, reference numeral 121, and page 12, lines 3-15) comprising the program information for a portion of the plurality of television programs where the search term is in a respective television program title (see e.g., Figure 9, such as the listing of "world" in the program titles).

Embodiments of the claimed subject matter, such as those defined by claim 39, define the method of claim 64 as further comprising presenting in a fourth IPG arrangement (see e.g., Figure 10, reference 130, and page 12, lines 16-22) a plurality of user-selected time periods in a displayed list (see e.g., Figure 10, reference numeral 96, and page 12, lines 16-22).

Embodiments of the claimed subject matter, such as those defined by claim 40, define the method of claim 39 as further comprising a step of causing a default time period selection to consist of the current day and the following day (see e.g., page 10, lines 17 – 36).

Embodiments of the claimed subject matter, such as those defined by claim 41, define the method of claim 39 as further comprising a step of causing a default time period selection to be the current day (see e.g., page 10, lines 17 – 36).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 2, 3, 5-30, 32-37 and 39-64 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

Claims 2, 3, 5-30, 32-37 and 39-64 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Rothmuller* ("*Rothmuller*," U.S. Pat. No. 5,635,989) in view of *Legall et al.* ("*Legall*," U.S. Pat. No. 6,005,565).

Claims 9-14 and 39-41 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Rothmuller* in view of *Legall*, and in further view of *Boyer et al.* ("*Boyer*," U.S. Pat. No. 6,268,849).

VII. ARGUMENT

A. Claim Rejections - 35 U.S.C. § 112, First Paragraph

Claims 2, 3, 5-30, 32-37, and 39-64 have been rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. As set forth above, claims 55-58 have been cancelled in the response after final, and hence the rejection has been rendered moot as allegedly applied to those claims. The Final Office Action alleges the following (page 2, section 1):

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the invention(s), at the time the application was filed, had possession of the claimed invention. In particular, claims 63 and 64, it is unclear as to where support is found for the claimed "...browse-by icon..." recited in claims 63 and 64. There is no disclosure for the claimed "browse-by icon." Furthermore the specification and figures as originally presented do not illustrates[sic] the claimed "browse-by icon."

Appellants respectfully disagree. In the response after final, Appellants included a marked-up copy of Figure 4 from Applicants' specification (identified as Exhibit A in Section IX of the present appeal brief), where a browse-by icon is manually circled for identification purposes (see, e.g., the triangle

symbol encompassing the letter "A" with the phrase "browse-by adjacent to the triangle symbol) as recited in claims 63 and 64. As set forth in MPEP 2163:

While there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure.

Thus, although Appellants note that the exact term "icon" is not explicitly presented verbatim in the specification ("option" is used instead in the specification), Appellants also note that the patent rules do not require identical language to be used between the specification and claims. Further, Appellants note that, based at least on Figure 4, it can reasonably be concluded that there is explicit support in the specification for the term "icon," and more specifically, the phrase "browse-by icon." Even assuming *arguendo* that there exists a lack of explicit support as alleged, at the very least, it can be reasonably concluded that there is implicit support.

Additionally, based on Figure 4 and the well-established use of the term "icon" in display and graphics user interface technology, one having ordinary skill in the art would reasonably conclude possession of the claimed subject matter. In that the rejection is believed to have been overcome, Appellants respectfully request that the rejection of these claims under 35 U.S.C. §112, first paragraph, be overturned.

The Advisory Action dated January 4, 2008 expressed that Exhibit A was considered, but disagreed with Appellants' arguments, asserting that "Exhibit A does not illustrate the claimed limitation 'BROWSE BY ICON'" and further asserting that there is "no disclosure for the claimed limitation 'browse-by-icon'. Hence the 103(a) rejection is proper."

Prior to filing an appeal brief, Appellants have requested consideration and entry of Exhibit 1 (see Section IX of the present appeal brief) under 37 CFR 41.37 and MPEP 1206. Exhibit 1 is a page containing an exemplary definition of the word "icon" from "Random House Webster's Unabridged Dictionary, Second Edition," dated August 1998. Such an exemplary definition

provides in relevant part as follows:

1. a picture, image, or other representation...4. *Computers*. A picture or symbol that appears on a monitor and is used to represent a command, as a file drawer to represent filing.

Appellants respectfully submit that, consistent with the exemplary definition as attached, the symbol "A" in Appellants' Figure 4 (Exhibit A) appears on the screen of a display device and is used in conjunction with the text adjacent the symbol (i.e., "Browse By") to represent or suggest the ability to use the "A" button or key on a remote control device to command browse-by functionality in the IPG in the manner described in Appellants' specification and as claimed (e.g., page 10, lines 8-16 and page 12, lines 16-22). Appellants note that as of August 15, 2008, review of the image file wrapper and transaction history of PAIR for the present application reveals no action taken on the Evidence submission. However, Appellants believe even absent the accompanying evidence (e.g., Exhibit 1), one having ordinary skill in the art would understand that the "A" symbol or graphic adjacent the "browse-by" text of Figure 4 is clearly a browse-by icon. Further, as Appellants note in the Evidentiary submission, there is an absence of any articulation in the Final or Advisory Action of "why" a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed (as required under MPEP 2163.04). Accordingly, Appellants respectfully submit that the claims are proper under 35 U.S.C. § 112, first paragraph, and respectfully request that the 112 rejection be overturned.

B. Claim Rejections - 35 U.S.C. § 103(a) - Claims 2, 3, 5-30, 32-37 and 39-64 and *Rothmuller* in view of *Legall*

Claims 2, 3, 5-30, 32-37 and 39-64 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Rothmuller* ("*Rothmuller*," U.S. Pat. No. 5,635,989) in view of *Legall et*

al. ("Legall," U.S. Pat. No.6,005,565). As set forth above, claims 55-58 have been cancelled in the response after final, and hence the rejection has been rendered moot as allegedly applied to those claims. For at least the reasons set forth herein, Appellants respectfully disagree with the rejection and request that the rejection be overturned.

The U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness according to the factual inquiries expressed in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The four factual inquiries, also expressed in MPEP 2100-116, are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

Appellants respectfully submit that a *prima facie* case of obviousness is not established using the art of record.

Independent Claim 63

Claim 63 recites (with emphasis added):

63. A programmable television services client device for enabling a user to search for television program information, said client device comprising:
memory comprising:
 program information corresponding to a plurality of television programs;
 an initial interactive program guide (IPG) arrangement; and
 a user interface (UI) module; and
a processor configured with the UI module to associate the program information with the initial IPG arrangement, the processor further configured with the UI module to:
 present the initial IPG arrangement on a display device, the initial IPG arrangement including a channel area, a first program display area adjacent the channel area, and **a browse-by icon;**
 receive a first user input corresponding to selection of the browse-by icon;
 present a first IPG arrangement on the display device responsive to the first user input, the first IPG arrangement comprising a browse-by area that displaces the channel area, the browse-by area having a search option;
 receive a second user input corresponding to selection of the search option;
 present a second IPG arrangement on the display device responsive to the second user input, the second IPG arrangement comprising a user input field that displaces the browse-by area;
 receive a third user input corresponding to a search term, the third user input entered through the user input field;
 search the program information based on the search term; and
 present a third IPG arrangement on the display device responsive to the search, the third IPG arrangement comprising a second program display area that displaces the user input field, the second program display area comprising a search result comprising the program information for a portion of the plurality of television programs where the search term is in a respective television program title.

Appellants respectfully submit that *Rothmuller* in view of *Legall* fails to disclose, teach, or suggest at least the above emphasized claim features. Initially, Appellants wish to point out that the Final Office Action addresses features not found in the claims in the manner claimed. For instance, on page 3 of the Final Office Action, the following is alleged (emphasis added):

Present the initial IPG arrangement on a display device, the initial IPG arrangement including a channel area, a first program display area adjacent the channel area, and a browse area; receive a first user input corresponding to selection of the browse area

Appellants do not claim that the “initial IPG arrangement” includes a browse-by area, but rather, a ***browse-by icon***. Likewise, the first user input corresponds to the selection of a ***browse-by icon***, not browse-by area.

Further, it is noted that the ***browse-by icon*** feature is not addressed anywhere in the Final Office Action, resulting in an improper omission of one or more essential elements necessary for a *prima facie* rejection. According to MPEP 2163, it would appear that at the very least, regardless of the outcome of the 35 U.S.C. 112, first paragraph analysis, the explicit claim features should be considered under at least 35 U.S.C. 102 and 103. That is, MPEP 2163 provides as follows:

The above only describes how to determine whether the written description requirement of 35 U.S.C. 112, para. 1, is satisfied. Regardless of the outcome of that determination, Office personnel must complete the patentability determination under all the relevant statutory provisions of title 35 of the U.S. Code.

There is no evidence that the above analysis was performed for the ***browse-by icon*** feature, and the Advisory Action does not even address this omission in the claim analysis.

Additionally, as set forth in the response after final, it is unclear from the Final Office Action where the features of ***present a first IPG arrangement on the display device responsive to the first user input, the first IPG arrangement comprising a browse-by area that displaces the channel area, the browse-by area having a search option*** are allegedly disclosed or taught in *Rothmuller*, or whether such features are taught at all. For instance, the Final Office Action alleges the following on page 3:

The first IPG (EPG-1) arrangement comprising a browse-by area that displaces the channel area, the browse-by area having a search option (favorite list, col. 5, lines 4-48).

The cited section from *Rothmuller* is in reference to Figures 1 and 2, which collectively not only fail to show a **browse-by area**, but also fail to disclose that the **browse-by area** has a **search option** or that the “browse-by area” **displaces the channel area** as claimed. The unclarity in the rejection stems from the fact that, regardless of what the Final Office Action alleges that *Rothmuller* shows (as alleged in the above reproduced section of the Final Office Action), further down the page (page 3) of the Final Office Action, the following contradictory admission is made:

Rothmuller fails to explicitly teach a user-selectable search option having browse-by area having a search option...

In addition, the Final Office Action alleges (page 4) that *Rothmuller* teaches the following (emphasis added):

The second IPG arrangement comprising a user input field that displaces the browse-by area; receive a third user input corresponding to a search term, the third user input entered through the user input field...present a third IPG arrangement...comprising a second program display area that displaces the user input field...(see fig. 2-4 and col. 4, line 29 – col. 5, line 3 and line 59-col. 6, line 39 and line 60-col. 7, line 9).

Appellants respectfully disagree that *Rothmuller* discloses these features. Additionally, and as set forth in the response after final, Appellants are perplexed as to the citations to *Rothmuller* provided by the final Office Action. Is the Final Office Action asserting that the relevant features alleged as taught in *Rothmuller* are to be found in column 4, line 29 through column 5, line 3 AND separately on line 59 of column 5? Or is the citation to col. 5, line 59 through column 6, line 39? Similarly, is the final Office Action alleging the features are taught in column 6, line 39 and in column 6, line 60 through column 7, line 9? That is, the hyphens are misleading. Again, these concerns are not addressed in the Advisory Action. Appellants respectfully submit that

the citations are not helpful in advancing prosecution on the merits. In any event, Appellants have reviewed the entirety of *Rothmuller*, and respectfully submit that the above-emphasized features as claimed are not disclosed, taught, or suggested. For instance, *Rothmuller* does not disclose, teach, or suggest the claimed **user input field**, nor a displacement of a browse-by area by the **user input field**. It is noted that the search features in *Rothmuller* appear to be remote control based (e.g., see column 5, and in particular, col. 5, line 3 of *Rothmuller*), and not accompanied by a user interface in the manner as claimed. Nor does *Rothmuller* disclose, teach, or suggest a displacement of the **user input field** with **a second program display area** that comprises a **search result**.

Additionally, Appellants respectfully submit that the addition of *Legall* fails to remedy the deficiencies of *Rothmuller*. The Final Office Action alleges the following on page 4 (no emphasis added):

However, note the **Legall** reference figs 2-4, discloses integrated search of electronic program guide, Internet and other information resources and further discloses a user-selectable search option having browse area and various guide arrangements and additional search options; Power Search area which is also a channel area for selecting channels to be searched, while retaining in a display, the program display area (figs.2 and 3B and col. 2, line 57-col. 5, line 1+), note that Legall clearly illustrates a display interface of multiple windows, one that displays the current tune channel and second window which includes a channel search area and also a power search area where a user selectable search option are displayed, and further discloses that once the user selects to proceed with the search, e.g., using "go" button 348...the EPG is updated (new EPG search parameters) to reflect those programs that meet the filter criteria, displayed over or in place of the old EPG within the channel area while retaining in a display, the program display area.

Appellants respectfully disagree. Initially, Appellants respectfully disagree with the allegation that the Power Search area is a **channel area**. Indeed, there is not a single channel listed in FIG. 3B in the area identified by 375. In the response after final, Appellants invited the Examiner to point to a single channel in the Power Search area 375. The Advisory Action did

not address this concern. The area identified with the EPG in the upper right hand corner of the display is clearly distinguishable from the power search area 375 residing in the middle of the display.

Further, assuming *arguendo* the Power Search area is construed by the Final Office Action as a **browse-by area**, though unclear from the Final Office Action as explained in the response after final (and again not addressed in the Advisory Action), Appellants respectfully submit that *Legall* fails to remedy the deficiencies of *Rothmuller* for at least the reason that a **browse-by icon** is not disclosed (or even alleged in the Final Office Action to be disclosed) by *Legall*.

Another reason *Legall* fails to remedy the deficiencies of *Rothmuller* is because *Legall* does not disclose the explicitly claimed displacement features (e.g., **comprising a browse-by area that displaces the channel area, user input field that displaces the browse-by area, a second program display area that displaces the user input field, the second program display area comprising a search result**). Clearly, there is no disclosed displacement in the manner claimed. Assuming *arguendo* there is an update of the EPG in *Legall*, that event alone is insufficient to disclose, teach, or suggest the claimed features for displacement. For instance, there is no teaching in *Legall* that the Power Search area (assuming for the sake of argument an equivalent to a **browse-by area**) displaces the channel area of the EPG. Likewise, as another example, there is no teaching in *Legall* that the topic window 340 (assuming for the sake of argument an equivalent to a **user input field**) displaces the Power Search area (assuming for the sake of argument an equivalent to a **browse-by area**).

Accordingly, for at least these reasons, Appellants respectfully submit that a *prima facie* case of obviousness is not established for independent claim 63, and hence respectfully request that the rejection be overturned.

Because independent claim 63 is allowable over *Rothmuller* and *Legall*, dependent claims 2, 3, 5-30, 59, and 60 are allowable as a matter of law for at least the reason that the dependent claims 2, 3, 5-30, 59, and 60 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, Appellants respectfully request that the rejection be overturned for at least the same reasons the rejection should be overturned for the base independent claim.

Additionally, Appellants wish to point out that the Final Office Action addresses more features not found in claim 63. For instance, on page 5 of the Final Office Action, the following is alleged (emphasis added):

The EPG is updated (new EPG search parameters) to reflect those programs that meet the filter criteria, displayed over or in place of the old EPG within the channel area while retaining in a display, the program display area.

That is, the above highlighted phrase is not found in the presently pending independent claim 63.

Independent Claim 64

Claim 64 recites (with emphasis added):

64. A method for implementing a programmable television services client device to enable a user to search for television program information, said method for implementing a programmable television services client device comprising the steps of:

presenting an initial IPG arrangement on a display device, the initial IPG arrangement including a channel area, a first program display area adjacent the channel area, **and a browse-by icon;**

receiving a first user input corresponding to selection of the browse-by icon;

presenting a first IPG arrangement on the display device responsive to the first user input, the first IPG arrangement comprising a browse-by area that displaces the channel area, the browse-by area having a search option;

receiving a second user input corresponding to selection of the search option;

presenting a second IPG arrangement on the display device responsive to the second user input, the second IPG arrangement comprising a user input field that displaces the browse-by area;

receiving a third user input corresponding to a search term, the third user input entered through the user input field;

searching the program information based on the search term; and

presenting a third IPG arrangement on the display device responsive to the search, the third IPG arrangement comprising a second program display area that displaces the user input field, the second program display area comprising a search result comprising the program information for a portion of the plurality of television programs where the search term is in a respective television program title.

Appellants respectfully submit that *Rothmuller* in view of *Legall* fails to disclose, teach, or suggest at least the above emphasized claim features. Appellants wish to point out that the Final Office Action addresses features not found in the claims in the manner claimed. For instance, on page 3 of the Final Office Action, the following is alleged (emphasis added):

Present the initial IPG arrangement on a display device, the initial IPG arrangement including a channel area, a first program display area adjacent the channel area, and a browse area; receive a first user input corresponding to selection of the browse area

Appellants do not claim that the “initial IPG arrangement” includes a browse-by area, but rather, a

browse-by icon. Likewise, the first user input corresponds to the selection of a **browse-by icon**, not browse-by area.

Further, it is noted that the **browse-by icon** feature is not addressed anywhere in the Final Office Action, resulting in an improper omission of one or more essential elements necessary for a *prima facie* rejection. According to MPEP 2163, it would appear that at the very least, regardless of the outcome of the 35 U.S.C. 112, first paragraph analysis, the explicit claim features should be considered under at least 35 U.S.C. 102 and 103. That is, MPEP 2163 provides as follows:

The above only describes how to determine whether the written description requirement of 35 U.S.C. 112, para. 1, is satisfied. Regardless of the outcome of that determination, Office personnel must complete the patentability determination under all the relevant statutory provisions of title 35 of the U.S. Code.

There is no evidence that the above analysis was performed for the **browse-by icon** feature, and the Advisory Action does not even address this omission in the claim analysis.

Additionally, as set forth in the response after final, it is unclear from the Final Office Action where the features of **presenting a first IPG arrangement on the display device responsive to the first user input, the first IPG arrangement comprising a browse-by area that displaces the channel area, the browse-by area having a search option** are allegedly disclosed or taught in *Rothmuller*, or whether such features are taught at all. For instance, the Final Office Action alleges the following on page 3:

The first IPG (EPG-1) arrangement comprising a browse-by area that displaces the channel area, the browse-by area having a search option (favorite list, col. 5, lines 4-48).

The cited section from *Rothmuller* is in reference to Figures 1 and 2, which collectively not only fail to show a **browse-by area**, but also fail to disclose that the **browse-by area** has a **search option** or that the “browse-by area” **displaces the channel area** as claimed. The unclarity in

the rejection stems from the fact that, regardless of what the Final Office Action alleges that *Rothmuller* shows (as alleged in the above reproduced section of the Final Office Action), further down the page (page 3) of the Final Office Action, the following contradictory admission is made:

Rothmuller fails to explicitly teach a user-selectable search option having browse-by area having a search option...

In addition, the final Office Action alleges (page 4) that *Rothmuller* teaches the following (emphasis added):

The second IPG arrangement comprising a user input field that displaces the browse-by area; receive a third user input corresponding to a search term, the third user input entered through the user input field...present a third IPG arrangement...comprising a second program display area that displaces the user input field...(see fig. 2-4 and col. 4, line 29 – col. 5, line 3 and line 59-col. 6, line 39 and line 60-col. 7, line 9).

Appellants respectfully disagree that *Rothmuller* discloses these features. Additionally, as set forth in the response after final, Appellants are perplexed as to the citations to *Rothmuller* provided by the final Office Action. Is the Final Office Action asserting that the relevant features alleged as taught in *Rothmuller* are to be found in column 4, line 29 through column 5, line 3 AND separately on line 59 of column 5? Or is the citation to col. 5, line 59 through column 6, line 39? Similarly, is the Final Office Action alleging the features are taught in column 6, line 39 and in column 6, line 60 through column 7, line 9? That is, the hyphens are misleading. Again, these concerns are not addressed in the Advisory Action. Appellants respectfully submit that the citations are not helpful in advancing prosecution on the merits. In any event, Appellants have reviewed the entirety of *Rothmuller*, and respectfully submit that the above-emphasized features as claimed are not disclosed, taught, or suggested. For instance, *Rothmuller* does not disclose, teach, or suggest the claimed **user input field**, nor a displacement of a browse-by area by the

user input field. It is noted that the search features in *Rothmuller* appear to be remote control based (e.g., see column 5, and in particular, col. 5, line 3 of *Rothmuller*), and not accompanied by a user interface in the manner as claimed. Nor does *Rothmuller* disclose, teach, or suggest a displacement of the **user input field** with **a second program display area** that comprises a **search result**.

Additionally, Appellants respectfully submit that the addition of *Legall* fails to remedy the deficiencies of *Rothmuller*. The Final Office Action alleges the following on page 4 (no emphasis added):

However, note the **Legall** reference figs 2-4, discloses integrated search of electronic program guide, Internet and other information resources and further discloses a user-selectable search option having browse area and various guide arrangements and additional search options; Power Search area which is also a channel area for selecting channels to be searched, while retaining in a display, the program display area (figs.2 and 3B and col. 2, line 57-col. 5, line 1+), note that Legall clearly illustrates a display interface of multiple windows, one that displays the current tune channel and second window which includes a channel search area and also a power search area where a user selectable search option are displayed, and further discloses that once the user selects to proceed with the search, e.g., using "go" button 348...the EPG is updated (new EPG search parameters) to reflect those programs that meet the filter criteria, displayed over or in place of the old EPG within the channel area while retaining in a display, the program display area.

Appellants respectfully disagree. Initially, Appellants respectfully disagree with the allegation that the Power Search area is a **channel area**. Indeed, there is not a single channel listed in FIG. 3B in the area identified by 375. Appellants have previously (in the response after final) invited the Examiner to point to a single channel in the Power Search area 375. The Advisory Action is non-responsive to this invitation. The area identified with the EPG in the upper right hand corner of the display is clearly distinguishable from the power search area 375 residing in the middle of the display.

Further, assuming *arguendo* the Power Search area is construed by the Final Office

Action as a **browse-by area**, though unclear from the Final Office Action (and again not addressed in the Advisory Action), Appellants respectfully submit that *Legall* fails to remedy the deficiencies of *Rothmuller* for at least the reason that a **browse-by icon** is not disclosed (or even alleged in the Final Office Action to be disclosed) by *Legall*.

Another reason *Legall* fails to remedy the deficiencies of *Rothmuller* is because *Legall* does not disclose the explicitly claimed displacement features (e.g., **comprising a browse-by area that displaces the channel area, user input field that displaces the browse-by area, a second program display area that displaces the user input field, the second program display area comprising a search result**). Clearly, there is no disclosed displacement in the manner claimed. Assuming *arguendo* there is an update of the EPG in *Legall*, that event alone is insufficient to disclose, teach, or suggest the claimed features for displacement. For instance, there is no teaching in *Legall* that the Power Search area (assuming for the sake of argument an equivalent to a **browse-by area**) displaces the channel area of the EPG. Likewise, as another example, there is no teaching in *Legall* that the topic window 340 (assuming for the sake of argument an equivalent to a **user input field**) displaces the Power Search area (assuming for the sake of argument an equivalent to a **browse-by area**).

Accordingly, for at least these reasons, Appellants respectfully submit that a *prima facie* case of obviousness is not established for independent claim 64, and hence respectfully request that the rejection be overturned.

Because independent claim 64 is allowable over *Rothmuller* and *Legall*, dependent claims 32-37, 39-54, 61, and 62 are allowable as a matter of law, and hence for the same reasons as expressed above for claim 64, the rejection should be overturned.

Additionally, Appellants wish to point out that the Final Office Action addresses features not found in claim 64. For instance, on page 5 of the Final Office Action, the following is alleged

(emphasis added):

The EPG is updated (new EPG search parameters) to reflect those programs that meet the filter criteria, displayed over or in place of the old EPG within the channel area while retaining in a display, the program display area.

That is, the above highlighted phrase is not found in the presently pending independent claim 64.

C. Claim Rejections - 35 U.S.C. § 103(a) - Claims 9-14 and 39-41 and *Rothmuller* in view of *Legall*, and in further view of *Boyer*

As explained above, Appellants respectfully submit that *Rothmuller* in view of *Legall* fails to disclose, teach, or suggest at least the above emphasized claim features for independent claims 63 and 64. Further, *Boyer* fails to remedy at least the above-emphasized features. Accordingly, Appellants respectfully submit that claims 9-14 and 39-41, which incorporate the respective base claim features, are allowable as a matter of law, and hence the rejection should be overturned.

For at least the forgoing reasons, it is Appellants' position that a *prima facie* for obviousness has not been made against Appellants' claims, and thus the rejections to the claims should be overturned.

CONCLUSION

Based upon the foregoing discussion, Appellants respectfully request that the Examiner's Final rejection of the claims be overruled and withdrawn by the Board, and that the application be allowed to issue as a patent with all pending claims.

In addition to the claims shown in the claims Appendix VIII, Appendix IX attached hereto indicates that there is evidence being attached and relied upon by this brief. Appendix X attached hereto indicates that there are no related proceedings.

Please charge the deposit account 20-0778 in the amount of \$510 for the filing of this Appeal Brief. No additional fees, outside of the extension of time fees requested under the accompanying petition, are believed to be due in connection with this Appeal Brief. If, however, any additional fees are deemed to be payable, you are hereby authorized to charge any such fees to deposit account No. 20-0778.

Respectfully submitted,

/dr/

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VIII. CLAIMS - APPENDIX

2. The programmable television services client device of claim 63, wherein the third user input comprises a text string.

3. The programmable television services client device of claim 63, wherein the first program display area is sorted by television program starting time and corresponds to a respective television channel provided in the channel area.

5. The programmable television services client device of claim 63, wherein said processor is further configured with said UI module to, responsive to user selection of the search result, cause a television program identified in the search result to be displayed on said display device.

6. The programmable television services client device of claim 63, wherein said display device comprises a television screen.

7. The programmable television services client device of claim 63, wherein said client device is coupled to a programmable television services server device and said program information is stored in the memory of the client device upon being received from said server device.

8. The programmable television services client device of claim 63, wherein the program information comprises a television program title for each of the plurality of television programs.

9. The programmable television services client device of claim 8, wherein the search is limited to television programs corresponding to a time period selected through user input from a list of two or more time periods.

10. The programmable television services client device of claim 9, wherein a default time period selection consists of the current day and the following day.

11. The programmable television services client device of claim 9, wherein a default time period selection is the current day.

12. The programmable television services client device of claim 9, wherein the time period is specified through user input.

13. The programmable television services client device of claim 9, wherein the portion of the plurality of television programs resulting from the search are scheduled during at least a part of said time period.

14. The programmable television services client device of claim 13, wherein the search result includes a television program title and a television program starting time.

15. The programmable television services client device of claim 63, wherein the search result is selectable by subsequent user input.

16. The programmable television services client device of claim 15, wherein said processor is further configured with said UI module to, responsive to user selection of the search result, cause a television program identified in the search result to be displayed on a viewing device.

17. The programmable television services client device of claim 63, wherein the third user input includes a sequence of sequentially input characters.

18. The programmable television services client device of claim 17, wherein the first, second, and third user inputs are received via a television remote control device.

19. The programmable television services client device of claim 17, wherein the first, second, and third user inputs are received via a remote keyboard.

20. The programmable television services client device of claim 17, wherein the first, second, and third user inputs are received via a keyboard coupled to the programmable television services client device.

21. The programmable television services client device of claim 17, wherein the search result is related to a television program title that contains the sequence of characters entered via the third user input.

22. The programmable television services client device of claim 21, wherein the search result includes a television program title.

23. The programmable television services client device of claim 22, wherein the search result includes a television program starting time.

24. The programmable television services client device of claim 23, wherein the search result identifies a television channel.

25. The programmable television services client device of claim 17, wherein the search result is related to a television program description that contains at least a portion of the sequence of characters.

26. The programmable television services client device of claim 25, wherein the search result includes a television program title.

27. The programmable television services client device of claim 26, wherein the search result includes a television program starting time.

28. The programmable television services client device of claim 27, wherein the search result identifies a television channel.

29. The programmable television services client device of claim 17, wherein the search result is selectable by subsequent user input.

30. The programmable television services client device of claim 29, wherein said processor is further configured with said UI module to, responsive to user selection of the search result, cause a television program identified in the search result to be displayed on said display device.

32. The method of claim 64, wherein the search result includes a television program title.

33. The method of claim 32, wherein the search result further includes a television program starting time and a channel number.

34. The method of claim 64, wherein the search result is selectable through user input.

35. The method of claim 34, further comprising a step of causing a television program identified in the search result to be displayed on said display device.

36. The method of claim 35, wherein said display device comprises a television screen.

37. The method of claim 64, wherein said client device is coupled to a server device via a television network and said program information is received by the client device via a television tuner in said client device.

39. The method of claim 64, further comprising presenting in a fourth IPG arrangement a plurality of user-selected time periods in a displayed list.

40. The method of claim 39, further comprising a step of causing a default time period selection to consist of the current day and the following day.

41. The method of claim 39, further comprising a step of causing a default time period selection to be the current day.

42. The method of claim 64, further comprising a step of causing a user-selected time period to be specified in a fourth IPG arrangement through user input.

43. The method of claim 42, further comprising a step of causing the displayed search result to be related to a television program that is scheduled to be broadcast during at least a part of said time period.

44. The method of claim 43, wherein the search result includes a television program title and a television program starting time.

45. The method of claim 64, further comprising a step of causing the search result to be selectable through subsequent user input.

46. The method of claim 45, further comprising a step of causing a television program identified in the search result to be displayed on the display device.

47. The method of claim 64, wherein the third user input comprises a sequence of characters.

48. The method of claim 47, further comprising a step of causing the first, second, and third user inputs to be received via a television remote control device.

49. The method of claim 47, further comprising a step of causing the first, second, and third user inputs to be received via a remote keyboard.

50. The method of claim 47, further comprising a step of causing the first, second, and third user inputs to be received via a keyboard coupled to the programmable television services client device.

51. The method of claim 47, wherein the search result is related to a television program title that contains at least a portion of the sequence of characters.

52. The method of claim 51, wherein the search result includes a television program title.

53. The method of claim 52, wherein the search result includes a television program starting time.

54. The method of claim 53, wherein the search result includes a television channel.

59. The programmable television services client device of claim 63, wherein the program information contains program data files of current and future television programs.

60. The programmable television services client device of claim 7, wherein the program information is received from a server via a television network.

61. The method of claim 64, wherein the program information contains program data files of current and future television programs.

62. The method of claim 64, wherein the program information is received from a server via a network.

63. A programmable television services client device for enabling a user to search for television program information, said client device comprising:

memory comprising:

program information corresponding to a plurality of television programs;

an initial interactive program guide (IPG) arrangement; and

a user interface (UI) module; and

a processor configured with the UI module to associate the program information with the initial IPG arrangement, the processor further configured with the UI module to:

present the initial IPG arrangement on a display device, the initial IPG arrangement including a channel area, a first program display area adjacent the channel area, and a browse-by icon;

receive a first user input corresponding to selection of the browse-by icon;

present a first IPG arrangement on the display device responsive to the first user input, the first IPG arrangement comprising a browse-by area that displaces the channel area, the browse-by area having a search option;

receive a second user input corresponding to selection of the search option;

present a second IPG arrangement on the display device responsive to the second user input, the second IPG arrangement comprising a user input field that displaces the browse-by area;

receive a third user input corresponding to a search term, the third user input entered through the user input field;

search the program information based on the search term; and

present a third IPG arrangement on the display device responsive to the search, the third IPG arrangement comprising a second program display area that displaces the user input field, the second program display area comprising a search result comprising the program information for a portion of the plurality of television programs where the search term is in a respective television program title.

64. A method for implementing a programmable television services client device to enable a user to search for television program information, said method for implementing a programmable television services client device comprising the steps of:

presenting an initial IPG arrangement on a display device, the initial IPG arrangement including a channel area, a first program display area adjacent the channel area, and a browse-by icon;

receiving a first user input corresponding to selection of the browse-by icon;

presenting a first IPG arrangement on the display device responsive to the first user input, the first IPG arrangement comprising a browse-by area that displaces the channel area, the browse-by area having a search option;

receiving a second user input corresponding to selection of the search option;

presenting a second IPG arrangement on the display device responsive to the second user input, the second IPG arrangement comprising a user input field that displaces the browse-by area;

receiving a third user input corresponding to a search term, the third user input entered through the user input field;

searching the program information based on the search term; and

presenting a third IPG arrangement on the display device responsive to the search, the third IPG arrangement comprising a second program display area that displaces the user input field, the second program display area comprising a search result comprising the program information for a portion of the plurality of television programs where the search term is in a respective television program title.

IX. EVIDENCE - APPENDIX

Exhibit A – marked-up copy of Appellants' Figure 4 from the filed application.

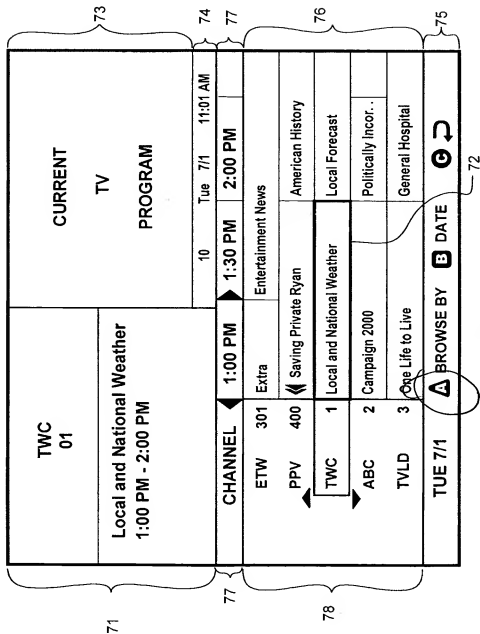
Exhibit 1 – exemplary definition of the word “icon” from “Random House Webster’s Unabridged Dictionary, Second Edition,” dated August 1998; submitted as Evidence Under 41.37 dated July 15, 2008.

IX. RELATED PROCEEDINGS- APPENDIX

None.

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TIME (CHANNEL) VIEW



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